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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,487

07/13/2004

Mitsuaki Oshima

AOY-3983US

9517

23122 7590 03/26/2008
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EXAMINER

TURK, NEIL N

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/501,487

Applicant(s)

OSHIMA, MITSUAKI

Examiner

NEIL TURK

Art Unit

1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendments to claim 19 add further limitations and recitations to the biomolecule bead-containing tube and storage device that would require further search and consideration. Further, claims 22-24 have been newly added and thereby have not been acted upon on the merits and would require further search and consideration. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11:

of arguments of record. Applicant asserts that it is unclear why claims 19 and 21 do not meet the requirements of 35 USC 112, 2nd paragraph. Examiner maintains the rejection and further asserts that it is unclear what connection there is to biomolecule and marker beads being arranged in a predetermined order and such an order corresponding to identification information. Is the identification information a further element of the tube (a bar code?), or is just an implicit function of the beads being arranged in a predetermined order? The recitation is further unclear and can be read as an implicit "if/then" recitation. This is seen because, as the claims read, if the beads are arranged in a predetermined order, then such an order implicitly corresponds to tube identification information. It is also unclear how such information would be optically read out as the claims are currently recited, as the claims recite such information corresponds to a predetermined order of beads. As currently recited, the tube identification information of claim 21 does not relate to the binary code or any other such code representative code as discussed in Applicant's arguments. Applicant's arguments with respect to claim 19 are moot as the claim has been amended to add recitations not previously acted upon on the merits. Applicant applies the same arguments as presented with respect to claim 19 to claim 21. Examiner first notes Applicant's arguments with respect to claim 19 are not commensurate in scope with that of claim 21, as claim 21 does not require a storage device, but merely recites storing the tube identification information in a memory. This recitation does not require the tube identification information to be stored in any specific memory or memory device, and such storing in a memory can be drawn to the implicit or intrinsic function of knowing the predetermined order that the beads have been set out in, as described in Kambara and Hauser. Examiner further asserts that such a step is taken by Kambara and Hauser, as Kambara discloses predetermined arrangements of marker and biomolecule beads so as to know the arraying order, and such an order would implicitly be stored in a memory of the user as the order is laid out in the predetermined fashion. Further, Hauser discloses a capillary tube having a plurality of beads aligned in a linear array, with each bead having a compound immobilized thereon that is identifiable by its spatial address within the linear array, thereby the spatially addressable array laid out in a predetermined order implicitly stores such identification information in a memory. Applicant's arguments with respect to newly added claims 22-24 are moot as the claims have not been previously acted upon the merits